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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,163	03/27/2002	Tokugen Yasuda	220482USOPCT	9786
22850	7590	03/29/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			MOORE, MARGARET G	
		ART UNIT	PAPER NUMBER	
		1712		

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)
	10/089,163	YASUDA ET AL
	Examiner Margaret G. Moore	Art Unit 1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 August 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 to 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 to 20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/23/05

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

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1. Claim 12 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. This claim refers to "said (poly)oxyalkylene group, but no such group is found in claim 1. It appears that this claim was intended to depend upon claim 11.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 to 5, 8 to 15 and 17 to 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Gruber et al.

This rejection relies on rationale of record. Applicants have amended claim 1 to include the phrase "consisting essentially of" in an effort to exclude the fluorinated component c) found in Gruber et al. To support their position applicants filed a declaration under 37 CFR 1.132 showing an ultimate strain test from a composition within the breadth of Gruber et al. This declaration is insufficient in overcoming the rejection.

First the Examiner notes that the comparison was not made against the closest prior art. The compound (B1) in the comparative example is not within the breadth of any of the claimed components (a) to (c). The comparison was not made against the closest prior art since Gruber et al. teach, as the oligovinyl component, a siloxane meeting claimed component (a). See component B2 on column 14. Second, there is nothing indicating or even suggesting that the fluorinated compound in the comparative example contributes to the inferior property. This could be a result of the compound (B1). Or this could be a result of the amount of each component. There is nothing that is indicative of any component's inherent ability to affect the basic and novel characteristics of the claimed composition.

On the other hand, the exemplified compositions of the claimed invention, found in the specification, are not representative of the claimed invention. Thus it is not clear if the ultimate strain results for these compositions can be extrapolated for the breadth

of the claims. For instance, the examples only use siloxanes having 40 or 60 repeating units while the claim embraces "m" values of from 0 to 300. For instance, an "m" value of 0 corresponds to compound B2 in Gruber et al.

While a clear and convincing showing of unexpected results must pertain to the full extent of the subject matter claimed, applicants are not required to test each and every species within the scope of the claims; rather, patentability is established by a showing of unexpected superiority for representative compounds within that scope. It is impermissible to extrapolate from the results obtained with a limited combination of components to expect the same unexpected results for broader combinations of components.

The facts presented to the Examiner simply do not support applicants' position that the phrase "consisting essentially of" in the instant claim excludes the fluorinated compound found in Gruber et al. There simply is not enough evidence to lead the skilled artisan to this conclusion.

The Examiner notes that newly added claims 8 to 15 and 17 to 20 are taught by Gruber. The component B2 on column 14 meets claims 8 to 13 (since claim 12 does not require that a (poly)oxyalkylene group be present). The component D1 meets claims 14 and 15. The component A1 meets claims 17 to 20.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gruber et al.

To provide clarification, the Examiner notes that these Y groups are drawn to mono-substituted groups, such that the cyclohexylmethyl group has only one methyl group. This differs from the component D1 used in the examples of Gruber et al. in that it is a trimethyl substituted cyclohexyl group. However column 6, line 4, teaches that the cycloalkyl groups used in this compound can contain from 1 to 5 lower alkyl groups. As such the skilled artisan would have found the selection of a mono-methylcyclohexyl group to have been obvious over the teachings of Gruber et al. because this reference expressly teaches using mono substituted groups in the alternative with tri substituted groups.

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5. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gruber as applied to claims 1 to 5 above, and further in view of JP 08227001.

This rejection relies on the reasons of record. As such they will not be repeated. Applicants rely on the alleged distinction of claim 1 from the teachings of Gruber et al. in an effort to overcome this rejection. Since this is not sufficient, as noted *supra*, the rejection is maintained.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
3/23/05